

### **REMARKS**

This communication responds to the *Office Action* dated January 6, 2010. Applicants have amended claims 1, 7, 15, 19, 25, 33, 37, 43, 51, 55, 61, and 69 for the sake of clarity only. Support for the claim amendments may be found at, for example, paragraph [0014] of Applicants' as-filed specification.<sup>1</sup> Claims 73-112 were previously canceled. No claims are presently canceled and no claims are added. Consequently, claims 1-72 remain pending in this application.

#### **Rejection of Claims Under 35 U.S.C. §112**

On page 2, paragraph 3 of the *Office Action*, the Examiner rejected claims 1-72 under 35 U.S.C. §112, second paragraph. The Examiner stated that the claims "recite the limitation 'dissimilar communication devices that have been abstracted' on the last line of each independent claim. There is insufficient antecedent basis for this limitation in the claim because the claims do not previously recite that the dissimilar communication devices are abstracted."<sup>2</sup>

Applicants have amended each of the independent claims, namely claims 1, 19, 37, and 55, to recite, *inter alia*, "an abstracted version of the dissimilar communication devices." Similar amendments were made in dependent claims 7, 15, 25, 33, 43, 51, 61, and 69. Applicants submit that the claims particularly point out and distinctly claim the subject matter that the Applicants regard as the invention. Additionally, since claims 2-6, 8-14, 16-18, 20-24, 26-32, 34-36, 38-42, 44-50, 52-54, 56-60, 62-68, and 70-72 depend from either claims 1, 19, 37, or 55, these dependent claims are also patent eligible for at least the same reasons as the claims from which they depend. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §112 with regard to claims 1-72.

#### **Rejection of Claims Under 35 U.S.C. §103(a)**

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<sup>1</sup> Paragraph numbers are given herein with reference to Applicants' U.S. Published Patent Application No. 2004/0213271.

<sup>2</sup> Emphasis in original.

On page 3, paragraph 6 of the *Office Action*, the Examiner rejected claims 1-8, 11-26, 29-44, 47-62, and 65-72 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,112,246 to Horbal et al. (*Horbal*), in view of U.S. Published Patent Application No. 2002/0143855 to Traversat et al. (*Traversat*). Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The U.S. Supreme Court decision of *KSR v. Teleflex* provided a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.<sup>3</sup>

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicants' claimed elements, with no change in the respective functions of the cited references, nor is there any substantiating evidence that any combination of the references would have yielded predictable results. "If any of these [three] findings cannot be made, then this rationale [of combining prior art elements according to known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious."<sup>4</sup> Although other rationales for rejection under 35 U.S.C. §103(a) may exist, the basis for an obviousness rejection is still grounded in a consideration of all claim elements. "All words in a claim must be considered in judging the patentability of that claim against the prior art."<sup>5</sup> Additionally, to render the claimed subject matter obvious, the prior art references must teach or suggest every feature of the claims.<sup>6</sup>

Applicants' independent claim 1 recites, *inter alia*,

<sup>3</sup> See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); see also MPEP § 2143, emphasis added.

<sup>4</sup> MPEP § 2143, emphasis added.

<sup>5</sup> *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03.

<sup>6</sup> See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaeck*, 947 F.2d, 488 (Fed. Cir. 1991)). Cited approvingly in *Ex parte WEN WEN* and *PATRICIA NG* at 7; Appeal No. 2009-000776; decided September 25, 2009.

[R]eceiving one or more responses from the discovery request from dissimilar communication devices on the network to at least partially determine a network topography, *the dissimilar communication devices having dissimilar communications standards*; and

*[T]ransmitting data between the communication device and the dissimilar communication devices* without requiring a proxy device to enable communications, the communication device and the dissimilar communication devices communicating through a common interface that operates in accordance with aspects of the communication device and an abstracted version of the dissimilar communication devices.<sup>7</sup>

Each of Applicants' other independent claims, namely claims 19, 37, and 55, share with claim 1 limitations similar to at least those recited immediately above.

The Examiner relied exclusively on *Horbal* to teach or suggest these claimed elements. However, in contrast to Applicants' claimed elements, *Horbal* discusses forcing all devices to standardize on a given protocol.

*A micro-server adapted to be embedded* into a piece of industrial machinery, an automobile, *a consumer product*, and the like . . . The micro-server is capable of interfacing with a device to access information from the device, such as control or maintenance information. *The micro-server can then organize and format that information compatible with a communication protocol.*<sup>8</sup>

Thus, *Horbal* is not concerned with the dissimilar communication devices that have dissimilar communications standards. *Horbal* ignores the entire dissimilar communication device issue by simply embedding a micro-server into each device and then applies the same protocol, such as HTTP, to each device.<sup>9</sup> Once the micro-server is embedded into each device, the devices can no longer be considered as being "dissimilar communication devices."

Consequently, a person of ordinary skill in the art concerned with the problem of dissimilar communication devices would not look to *Horbal* to remedy the problem. *Horbal*

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<sup>7</sup> Emphasis added.

<sup>8</sup> *Horbal* at Abstract; emphasis added.

<sup>9</sup> See, for example, "FIG. 4 is a simplified block diagram showing possible components of a micro-server." (*Horbal* at col. 8, lines 20-21.) Element 422 on the micro-server is an "HTTP Protocol Server." (*Id.* at Fig. 4.)

discusses embedding a new micro-server into each device, thus making them all *similar* communications devices, and then implementing the same communications standard into each similar communications device.

Thus, *Horbal effectively teaches away from the recitations of Applicants' claimed elements*. As noted above, Applicants' independent claims each recite, *inter alia*, "transmitting data between *dissimilar communications devices* . . . through a common interface."<sup>10</sup> Applying the embedded micro-server of *Horbal* obviates the necessity for transmitting data between dissimilar communications devices since all devices would share a common protocol. The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art.<sup>11</sup>

At the very least, the respective functions of *Horbal* would be changed significantly to attempt to adopt the teachings or suggestions contained therein into Applicants' recited claims. Even if the respective functions could be changed (which would change the basic premise of *Horbal*), the Examiner provides no substantiating evidence that the changed respective functions of *Horbal* would yield predictable results. Although the Examiner did not rely on *Traversat* to teach or suggest the claimed elements discussed above, *Traversat* still fails to make up for any of the deficiencies neither taught nor suggested by *Horbal*.

Since Applicants have shown that not all the claimed elements were known as required, with no change in the respective functions or with any assurance of predictable results, either by *Horbal* singly or in combination with *Traversat*, Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 1, 19, 37, and 55. Further, since the other claims rejected under this section depend, either directly or indirectly from claims 1, 19, 37, or 55, , they too are allowable for at least the same reasons as the claims from which they depend. Further, these dependent claims each may contain additional patentable subject matter.

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<sup>10</sup> Applicants' independent claim 1. Applicants' other independent claims, namely claims 19, 37, and 55 each share similar limitations with claim 1.

<sup>11</sup> *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990).

On page 8, paragraph 28 of the *Office Action*, the Examiner rejected claims 9, 10, 27, 28, 45, 46, 63, and 64 under 35 U.S.C. §103(a) as being unpatentable over *Horbal* in view of *Traversat*, as applied to claims 4, 22, 40, and 58 respectively above, and further in view of U.S. Published Patent Application No. 2002/0099867 to Wilkinson et al. (*Wilkinson*). However, each of these claims depend either directly or indirectly from one of the independent claims, 1, 19, 37, or 55, that Applicants have shown to be allowable. *Wilkinson* does nothing to cure the deficiencies not found in either *Horbal* or *Traversat*. Thus, each of these dependent claims are allowable for at least the same reasons as given above with regard to the independent claims from which they depend. Further, each of these dependent claims may be allowable for its own limitations.

**CONCLUSION**


Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned attorney at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5<sup>th</sup> day of April, 2010.

  
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